

REMARKS

The Examiner is thanked for the due consideration given the application. This Response is being submitted in light of the Advisory Action mailed June 3, 2008. This response submits evidence in the form of a letter from Professor Sergio Pimpinelli of the University of Rome.

Claims 18-21, 35 and 36 are pending in the application. Claims 18 and 36 have been withdrawn from consideration. No new matter is believed to be added to the application by this Response.

The Advisory Action mailed June 3, 2008 set forth the following issues remaining in the application:

1. A requirement for information under 37 CFR §1.105 in regards to the availability of P. LANEVE (*Purificazione e caratterizzazione di una nuova attività endoribonucleolitica coinvolta nella biosintesi dei piccoli RNA nucleolari in X. Laevis*, Department of Genetics and Molecular Biology, University La Sapienza of Rome, Italy, 2001).

2. The rejection under 35 USC §102(b) of Claims 19 and 35 as being anticipated by P. LANEVE.

3. The rejection under 35 USC §103(a) of claims 20 and 21 as being unpatentable over P. LANEVE.

This Response fulfills the requirement under 37 CFR §1.105, removes P. LANEVE as prior art, and thus traverses and overcomes the rejection over P. LANEVE.

As is discussed in MPEP 2128.01, a doctoral thesis indexed and shelved in a library is sufficiently accessible to the public to constitute prior art as a "printed publication." *In re Hall*, 781 F.2d 897, 228 USPQ 453 (Fed. Cir. 1986). Even if access to the library is restricted, a reference will constitute a "printed publication" as long as a presumption is raised that the portion of the public concerned with the art would know of the invention. *In re Bayer*, 568 F.2d 1357, 196 USPQ 670 (CCPA 1978).

In *In re Hall*, general library cataloging and shelving practices showed that a doctoral thesis deposited in university library would have been indexed, cataloged and shelved and thus available to the public before the critical date. Compare *In re Cronyn*, 890 F.2d 1158, 13 USPQ2d 1070 (Fed. Cir. 1989) wherein doctoral theses were shelved and indexed by index cards filed alphabetically by student name and kept in a shoe box in the chemistry library. The index cards only listed the student name and title of the thesis. Two of three judges held that the students' theses were not accessible to the public. The court reasoned that the theses had not been either cataloged or indexed in a meaningful way since thesis could only be found if the researcher's name was known, but the name bears no relationship to the subject of the thesis.

In this case, the P. LANEVE thesis was orally discussed in 2001, but the thesis was never placed in a library (main or

departmental library), or bookshelf or any place available to the public.

The P. LANEVE thesis only came to be listed in the International Search Report due to a citation as a reference in online Database EMBL (online), *Xenopus laevis* mRNA for endo U protein, 5 September 2002, Caffarelli E.; Database accession no. AJ507315 XP002258141.

Nonetheless, this passing citation to P. LANEVE in a database entry fails to address the unavailability of P. LANEVE because this thesis was not placed in a library available to the public, and it had neither been catalogued nor indexed in a meaningful way. That is, this passing citation to P. LANEVE fails to fulfill the requirements for a thesis to be considered as prior art, as discussed above.

The attached letter from Professor Sergio Pimpinelli of the University of Rome attests to the non-availability of P. LANEVE and fulfills the requirement for information under 37 CFR §1.105.

P. LANEVE is thus not prior art to the present invention.

The Examiner is accordingly respectfully requested to withdraw the rejections over P. LANEVE.

Conclusion

Entry of this response under 37 CFR §1.116 is respectfully requested because it places the application in condition for allowance.

The rejections are believed to be overcome, obviated or rendered moot and that no issues remain. The Examiner is accordingly respectfully requested to place the application in condition for allowance and to issue a Notice of Allowability.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

YOUNG & THOMPSON



Robert E. Goozner, Reg. No. 42,593
209 Madison Street
Suite 500
Alexandria, VA 22314
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

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APPENDIX:

The Appendix includes the following item(s):

- a letter from Professor Sergio Pimpinelli of the University of Rome



Roma 24-07-2008

To whom it may concern

We declare that the thesis by Pietro Laneve having title "Purificazione e caratterizzazione di una nuova attività endoribonucleolitica coinvolta nella biosintesi dei piccoli RNA nucleolari in *X. Laevis*", Department of Genetics and Molecular Biology, University of Rome La Sapienza, Italy, orally discussed on 2001, was never placed in a library (main or departmental library) or bookshelf or any place for public browsing.

Thesis Laneve came to be listed in the International Search Report because it was only cited as reference in document D2: Database EMBL (online), *Xenopus laevis* mRNA for endo U protein, 5 September 2002, Caffarelli E.; Database accession no. AJ507315 XP002258141.

Prof. Sergio Pimpinelli

Director of Department of Genetics and Molecular Biology
University of Rome "La Sapienza"